UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,890	01/25/2001	Chi-Sheng Chang	E0887	4979

7590   07/19/2004

M. David Galin
Renner, Otto, Boisselle, & Sklar, L.L.P.
19th Floor
1621 Euclid Avenue
Cleveland, OH 44115

EXAMINER
SHEW, JOHN

ART UNIT	PAPER NUMBER
2664	

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,8</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>2</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Specification

Double Patenting

1.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2.   Claims 1 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 13 of copending Application No. 09/769982. Although the conflicting claims are not identical, they are not patentably distinct from each other because the control block would have been obvious in view of the claimed PCI control of claim 4 of the copending application.

Claim 1, cites "A networking interface device for coupling a system host having one of a plurality configurations to a network medium, comprising: a peripheral component interconnect (PCI) interface for coupling the interface device to a system host configured with a PCI based system bus interface; a medium independent interface (MII) for coupling the interface device to a system host configured with a media access controller (MAC) based system bus interface;".

Application 09/769982 claim 1 cites "A networking interface device for coupling a system host having one of a plurality configurations to a network medium comprising: a peripheral component interconnect (PCI) interface for coupling the interface device to a system host configured with a PCI based system bus interface; a medium independent interface (MII) for coupling the interface device to a system host configured with a media access controller (MAC) based system bus interface;".

Claim 1 cites "a control block for determining whether the interface device is operably coupled to a system host having a PCI based system bus interface or a MAC based system bus interface, wherein the control block determines that the interface device is coupled to a system host having a MAC based system bus interface by detecting the presence of at least one of a management data clock (MDC) or a management data input/output (MDIO) signal transmitted from an MII on the system bus interface to the MII of the interface device".

Application 09/769982 claim 1 cites " a PCI control block for managing network data packet traffic exchange between the interface device and the system host".

Application 09/769982 claim 4 which is dependent on claim 1 cites " wherein the
interface device determines whether the interface device is operably coupled to a
system host having a PCI based system bus interface or a MAC based system bus
interface by detecting the presence of at least one of a management data clock (MDC)
or a management data input/output (MDIO) signal transmitted from an MII on the
system bus interface to the MII of the interface device".
Application 09/769982 claims a PCI control block, which is obviously the same as the
claimed control block.

Claim 8 cites "A method of operably coupling a system host to a network medium using
an interface device, the system host having either a peripheral component interconnect
(PCI) based system bus interface or a media access controller (MAC) based system
bus interface, the method comprising the steps of:".
Application 09/769982 claim 8 cites "A method of operably coupling a system host to a
network medium using an interface device, the system host having either a peripheral
component interconnect (PCI) based system bus interface or a media access controller
(MAC) based system bus interface, the method comprising the steps of:".

Claim 8 cites "detecting the presence or absence of at least one of a management data
clock (MDC) or a management data input/output (MDIO) signal transmitted from a
medium independent interface (MII) on the system bus interface to an MII of the

interface device, the presence of the at least one of the MDC or the MDIO indicating the

system host has a MAC based system bus interface;"

Application 09/769982 claim 8 cites "detecting the type of system bus interface of the

system host;".

Application 09/769982 claim 12 which is dependent on claims 8 and 9 cites " wherein

the step of detecting the type of system bus interface of the system host includes

detecting the presence or absence of at least one of a management data clock (MDC)

or a management data input/output (MDIO) signal transmitted from a medium

independent interface (MII) on the system bus interface to an MII of the interface device,

the presence of the at least one of the MDC or the MDIO indicating the system host has

a MAC based system bus interface".

Claim 8 cites "reconfiguring a buffer management unit (BMU) from an active state for

bursting data packet traffic for the PCI based system bus interface to a passive state for

continuously passing data packet traffic for the MAC based system bus interface".

Application 09/769982 claim 9 which is dependent on claim 8 cites "configuring a buffer

management unit (BMU) from an active state to a passive state".

Application 09/769982 claim 13 which is dependent on claims 8, 9, 12 cites "generating

a suspend burst signal used to reconfigure the BMU from the active state for bursting

data packet traffic for the PCI based system bus interface to the passive state for

continuously passing data packet traffic for the MAC based system bus interface".

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Citation of Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patent 5784573, Szczepanek discloses a multi-protocol LAN controller. Patent 6564280, Walsh discloses a communication controller for optimal resource usage.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L Shew whose telephone number is 703-305-8708. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 703-305-4366. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

js

WELLINGTON CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600